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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,686	02/22/2002	Faruk Mehmet Omer Eryurtlu	Eryurtlu -3	3747

7590 07/12/2005

Lucent Technologies Inc
Docket Administrator Room 3J 219
101 Crawfords Corner Road
Holmdel, NJ 07733-3030

EXAMINER

TORRES, JOSEPH D

ART UNIT	PAPER NUMBER
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2133

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,686

Applicant(s)

ERYURTLU, FARUK MEHMET
OMER

Examiner

Joseph D. Torres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 6 is objected to because of the following informalities: claim 6, as written, appears to be a preamble with no body. Accordingly, claim 6 has not been further treated on the merits (Note: a preamble is not normally given patentable weight; hence there is nothing to examine as claim 6 is written).

Appropriate correction is required.

Objections to the Specification

2. Claim 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites "a decoder for receiving encoded video signals produced by an encoder in a transmitter, the encoder being selectively operative to transmit only differences between selected macroblocks in successive frames when a specific difference criteria between said successive blocks is not exceeded, together with a mode indicator signal indicative of whether or not the last macroblock was encoded in inter-frame prediction format or not". Nowhere in the specification does the Applicant teach "a decoder for receiving encoded video signals produced by an encoder in a transmitter, the encoder being selectively operative to

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transmit”... “a mode indicator signal indicative of whether or not the last macroblock was encoded in inter-frame prediction format or not”, in fact, nowhere in the specification does the Applicant even mention the term “mode indicator signal”.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim, which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.).

As written claim 6 has no body; hence just as in a single means claim, the Applicant has not taught ever conceivable means for achieving the unstated limitations in the body of the claim since at this point, the unstated limitations in the body of the claim can be anything.

Claim 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites “a decoder for receiving encoded video signals produced by an encoder in a transmitter, the encoder being selectively operative to transmit only differences between selected macroblocks in successive frames when a specific difference criteria between said successive blocks is not exceeded, together with a mode indicator signal indicative of whether or not the last macroblock was encoded in inter-frame prediction format or not”. Nowhere in the specification does the Applicant teach “a decoder for receiving encoded video signals produced by an encoder in a transmitter, the encoder being selectively operative to transmit”... “a mode indicator signal indicative of whether or not the last macroblock was encoded in inter-frame prediction format or not”, in fact, nowhere in the specification does the Applicant even mention the term “mode indicator signal”.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See

MPEP § 2172.01. The omitted structural cooperative relationships in claims 1-6 are: the relationship between “macroblocks” and “frame” (Note it is not clear whether frames are comprised of macroblocks, macroblocks are comprised of frames or whether there are 2 and a half macroblocks per frame, etc.).

The omitted structural cooperative relationships in claims 1-6 are: the relationship between “macroblocks”, “frame” and “blocks”.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As written claim 6 has no body; hence is indefinite.

Claim 1 recites the limitation "said successive blocks" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the last macroblock" in line 4. There is insufficient antecedent basis for this limitation in the claim. Furthermore since “last” is a relative term and the relationship between frames and macroblocks is not known, it is not clear what “last” refers to, that is, is it the last macroblock in a succession of macroblocks or the last macroblock in a frame, etc?

Claim 4 recites the limitation "the present macroblock" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the corresponding macroblock of an immediately preceding frame" in line 6. There is insufficient antecedent basis for this limitation in the

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claim. Furthermore, since the relationship between macroblocks and frames is indefinite it is not clear how a macroblock can correspond to a frame.

Claim 5 recites the limitation "a corresponding macroblock of an immediately preceding frame" in line 6. Since the relationship between macroblocks and frames is indefinite it is not clear how a macroblock can correspond to a frame.

Claim 6 recites the limitation "said successive blocks" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the last macroblock" in line 10. There is insufficient antecedent basis for this limitation in the claim. Furthermore since "last" is a relative term and the relationship between frames and macroblocks is not known, it is not clear what "last" refers to, that is, is it the last macroblock in a succession of macroblocks or the last macroblock in a frame, etc?

Claim 6 recites the limitation "the present macroblock" in lines 17-18. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the corresponding macroblock of an immediately preceding frame" in lines 18-19. There is insufficient antecedent basis for this limitation in the claim. Furthermore, since the relationship between macroblocks and frames is indefinite it is not clear how a macroblock can correspond to a frame.

Response to Arguments

5. Applicant's arguments filed 04/25/2005 have been fully considered but they are not persuasive.

The Applicant contends, “This has been clarified in amended claim 1, which now requires a mode indicator signal set by the encoder 'indicative of whether or not the last macroblock was encoded in inter-frame prediction format'. This clearly distinguishes over Urano...”.

In response to applicant's arguments, the recitation 'indicative of whether or not the last macroblock was encoded in inter-frame prediction format' has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The Applicant contends, “This is in contrast to the present invention which concerns **decompression and decoding at a receiver**, involving comparison of current and previous frames to determine whether interframe-prediction format was applied or not, and comparison of the result with a mode indicator signal received from the transmitter in order to detect errors” [Emphasis added].

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “decompression and decoding at a receiver”) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant contends, “This is in contrast to the present invention which concerns decompression and decoding at a receiver, involving comparison of current and previous frames to determine whether interframe-prediction format was applied or not, and comparison of the result with **a mode indicator signal received from the transmitter** in order to detect errors” [Emphasis added].

In response to applicant's arguments, the recitation “encoded video signals produced by an encoder in a transmitter, the encoder being selectively operative to transmit only differences between selected macroblocks in successive frames when a specific difference criteria between said successive blocks is not exceeded, together with a mode indicator signal indicative of whether or not the last macroblock was encoded in inter-frame prediction format or not; the receiver” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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The Applicant contends, "Furthermore, for completeness, the passage cited in column 14, lines 57 to 60 does not teach comparison of that result with a mode indicator signal received from the transmitter and indicative of whether or not inter-frame prediction was applied in compression before transmission".

In response to applicant's arguments, the recitation "encoded video signals produced by an encoder in a transmitter, the encoder being selectively operative to transmit only differences between selected macroblocks in successive frames when a specific difference criteria between said successive blocks is not exceeded, together with a mode indicator signal indicative of whether or not the last macroblock was encoded in inter-frame prediction format or not; the receiver" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The Applicant contends that claims 2-5 are allowable on the basis of the arguments presented for claim 1. As pointed out, above, by the Examiner, claim 1 is not allowable for the above cited reasons; hence neither are claims 2-5.

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The Examiner disagrees with the applicant and maintains all rejections of claims 1-7, 9-13, 19, 20 and 22. All amendments and arguments by the applicant have been considered. It is the Examiner's conclusion that claims 1-7, 9-13, 19, 20 and 22 are not patentably distinct or non-obvious over the prior art of record in view of the references, Gray; Scott L. et al. (US 5086429 A, hereafter referred to as Gray) as applied in the Non-Final office action, filed 03/23/2005. Therefore, the rejection is maintained.

See the Non-Final Action filed 03/23/2005 for detailed action of prior rejections.

All amendments and arguments by the applicant have been considered. It is the Examiner's conclusion that claims 1-3 and 5 are not patentably distinct or non-obvious over the prior art of record in view of the reference, Urano; Takashi et al. (US 5767898 A, hereafter referred to as Urano) as applied in the last office action, filed 07/28/2004. Therefore, the rejection is maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Urano; Takashi et al. (US 5767898 A, hereafter referred to as Urano).

35 U.S.C. 102(b) rejection of claims 1-3 and 5.

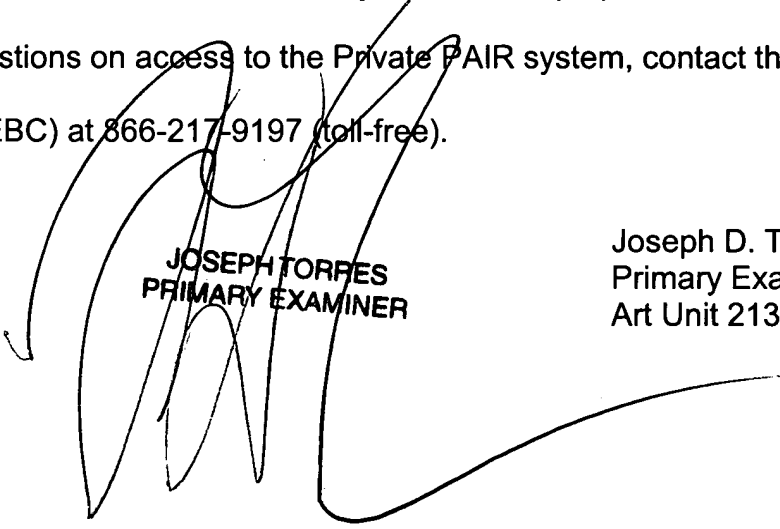
See the Non-Final Action filed 07/28/2004 for detailed action of prior rejections.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Torres whose telephone number is (571) 272-3829. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**JOSEPH TORRES
PRIMARY EXAMINER**

Joseph D. Torres, PhD
Primary Examiner
Art Unit 2133